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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Missako Franchising, S.A.

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Serial No. 78254972

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Leonard Tachner, Esq. for Missako Franchising, S.A.

Midge F. Butler, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

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Before Quinn, Hohein and Kuhlke, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Missako Franchising, S.A. to register the mark shown below

for "clothing and related clothing accessories, namely, Bermuda shorts, shirts, bikinis, shorts, sweaters, swim trunks, scarves, short jackets, undershirts, bikini

panties, blouses, polo shirts, athletic shirts, skirts, bathing suits, coats, hats, slippers, belts, pajamas, underpants, panties, socks, panty hose, dresses and trousers" in International Class 25.[1] The literal portion of the mark reads "GREEN BY MISSAKO."[2] Applicant disclaimed the word "Green" apart from the mark.

The trademark examining attorney refused registration in Class 25 under Section 2(d) of the Trademark Act on the ground that applicant's mark, if applied to applicant's goods, would so resemble the previously registered mark GREEN for "footwear"[3] and "men and children's dress shoes, dress casual shoes, casual shoes, boots, men, women and children's sandals, huaraches, and slippers"[4] as to be likely to cause confusion. The same entity owns both registrations.

When the refusal was made final in Class 25, applicant appealed. Applicant and the examining attorney filed

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[1] Application Serial No. 78254972, filed May 28, 2003, based on an allegation of a bona fide intention to use the mark in commerce. The application also includes services in International Class 35. The final refusal pertained to Class 25 only. The application, as originally filed, included a claim of priority under Section 44(d) of the Trademark Act based on a Brazilian application; this basis subsequently was withdrawn in applicant's request for reconsideration.

[2] The words "BY MISSAKO," appearing at the bottom of the mark, are in a relatively small font size, and the words do not reproduce well in the image as shown.

[3] Registration No. 1151799, issued April 21, 1981; renewed.

[4] Registration No. 2343501, issued April 18, 2000.

briefs. An oral hearing was not requested.

Applicant, in urging that the refusal be reversed, relies on three main arguments: that the term "green" is in common use in the clothing field such that the commonality of the term in the involved marks is an insufficient basis upon which to base a finding of likelihood of confusion; that the sun burst design (or daisy flower-like design) in applicant's mark dominates the term GREEN in its mark;[5] and that the presence of BY MISSAKO in applicant's mark makes the likelihood of confusion even more remote. In support of its arguments, applicant submitted seventy-one third-party registrations of marks that include the term GREEN covering clothing and footwear.

The examining attorney maintains that applicant's mark is dominated by the literal portion, GREEN, and that this word is identical to the entirety of registrant's mark. The examining attorney also contends that the goods are related and, in this connection, she submitted several use-based third-party registrations showing the same entity has registered the same mark for both clothing and footwear.

Our determination of the issue of likelihood of

[5] Applicant, in its request for reconsideration, refers to the design feature in its mark as a "daisy flower-like design." In its appeal brief, applicant describes the design as both a "sun burst design" and a "daisy flower design."

confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first turn to consider the goods. Throughout the prosecution of its application, applicant was conspicuously silent on this du Pont factor; moreover, applicant's brief is devoid of any remarks directed to the goods, failing to offer any response in its brief to the examining attorney's contention that the goods are related.

It is not necessary that the respective goods be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such

that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

We acknowledge that there is no *per se* rule governing likelihood of confusion in cases involving clothing items. In re British Bulldog, Ltd., 224 USPQ 854 (TTAB 1984). At the same time, we note that likelihood of confusion has been found in prior cases where it was determined that goods of the same kind as or analogous to those involved herein are related for the purpose of deciding likelihood of confusion issues. See Cambridge Rubber Co. v. Cluett, Peabody & Co., Inc., 286 F.2d 623, 128 USPQ 549 (CCPA 1961) [WINTER CARNIVAL for women’s boots and men’s and boy’s underwear]; General Shoe Co. v. Hollywood-Maxwell Co., 277 F.2d 169, 125 USPQ 443 (CCPA 1960) [INGENUE for shoes and INGENUE for brassieres]; Avon Shoe Co. v. David Crystal, Inc., 279 F.2d 607, 125 USPQ 607 (2d Cir. 1960) [HAYMAKERS for women's shoes and HAYMAKER for women's sportswear, including blouses, shirts, and dresses]; In re Keller, Heumann & Thompson Co., 81 F.2d 399, 28 USPQ 221 (CCPA 1936) [TIMELY for men's shoes and TIMELY for men's suits,

topcoats and overcoats]; Villager, Inc. v. Dial Shoe Co., 256 F.Supp. 694, 150 USPQ 528 (E.D.Pa. 1966) [THE VILLAGER and JUNIOR VILLAGER for young women's wearing apparel, including inter alia, dresses, skirts, blouses, slacks, jackets, and MISS VILLAGER for shoes]; In re Pix of America, Inc., 225 USPQ 691 (TTAB 1985) [NEWPORTS for women’s shoes and NEWPORT for outer shirts]; and United States Shoes Corp. v. Oxford Industries, Inc., 165 USPQ 86 (TTAB 1970) [COBBIES BY COS COB for women's and girl's shirt-shifts and COBBIES for shoes].

As the Board stated in In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991):

> In this case we have women's shoes, on the one hand, and women's pants, blouses, shorts and jackets, on the other. Despite applicant’s argument to the contrary, we believe that these goods are related. A woman's ensemble, which may consist of a coordinated set of pants, a blouse and a jacket, is incomplete without a pair of shoes that match or contrast therewith. Such goods are frequently purchased in a single shopping expedition. When shopping for shoes, a purchaser is usually looking for a shoe style or color to wear with a particular outfit. The items sold by applicant and registrant are considered to be complementary goods. They may be found in the same stores, albeit in different departments.

Notwithstanding the specific differences between clothing items and footwear, we find them to be sufficiently related for the same reasons quoted above, that, when sold under similar marks, purchasers are likely to be confused. The respective goods travel in the same trade channels (department stores, clothing stores, and the like), and the goods would be bought by the same purchasers. These purchasers would include ordinary consumers who, in making purchases of clothing and footwear, would exercise nothing more than ordinary care. Moreover, due to the normal fallibility of human memory over time, these purchasers would retain a general rather than a specific impression of trademarks encountered in the marketplace. See Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

Further, in the present case, the examining attorney submitted several use-based third-party registrations issued to entities showing that each entity adopted the same mark for clothing items and footwear. Third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods are of a type that may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

We next turn to consider the marks. In determining the similarity or dissimilarity of the marks, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result. As noted above, the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper, for rational reasons, to give more weight to this dominant feature in determining the commercial impression created by the mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applicant’s mark, as reproduced above, is GREEN BY MISSAKO and a design. Registrant’s cited mark is GREEN in standard character form. Applying the above principles in

the present case, we find that applicant's mark is sufficiently similar to registrant's mark that, when applied to clothing and footwear, confusion would be likely to occur among consumers in the marketplace.

There is no question that the design portion plays a prominent role in the commercial impression engendered by applicant's mark. However, applicant's argument that the design element (whether a sun burst or a daisy flower) is the dominant portion of its mark is not well taken. The literal portion of applicant's mark, GREEN BY MISSAKO, which in turn is clearly dominated by GREEN, dominates applicant's mark. The word GREEN is prominent in terms of size to the design feature. Moreover, the word GREEN, which is identical to the entirety of registrant's mark, is more likely to be remembered by consumers and used when calling for the goods. Although the literal portion does include the words BY MISSAKO, this portion is very small in size compared to GREEN, and purchasers will likely use only the GREEN portion in calling for the goods. As such, the literal element, GREEN, is the dominant element of the mark and is therefore accorded greater weight in determining the likelihood of confusion. Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A., 32 USPQ2d 1192 (TTAB 1994); and In re Appetito Provisions Co., 3 USPQ2d 1553

(TTAB 1987). Although applicant is correct in pointing out that the Federal Circuit has cautioned that there is no general rule as to whether words or a design dominate in any particular mark, it is highly unlikely that consumers will call for applicant's goods by "the sun burst design" or "the daisy flower design"; rather, given the easily pronounced and one-syllable word "Green," it is far more likely that this term will be used by customers in buying applicant's clothing.

The GREEN portion of applicant's mark is identical in sound to the entirety of registrant's mark GREEN.

As to appearance, the GREEN portion of applicant's mark is stylized, but not in a significant fashion. Registrant's mark GREEN is presented in standard characters; thus, registrant is not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording and not in any particular display. The registered mark presumably could be used in the same manner of minimally stylized display as in applicant's mark. See, e.g., Jockey International Inc. v. Mallory & Church Corp., 25 USPQ2d 1233 (TTAB 1992), citing INB National Bank v. Metrohost Inc., 22 USPQ2d 1585 (TTAB 1992); and In re Melville Corp., supra at 1388.

With respect to connotation, applicant offers the following argument: "The term 'GREEN' standing alone might connote color. In a certain setting, however, it connotes fresh flowers or healthy plants, the great outdoors and a clean environment. Thus, in placing a looming sun burst design over the word 'GREEN,' [applicant's] mark creates the impression of a child's garden, a sense reinforced by the child-like lettering design of the word 'green.'" (Appeal Brief, p. 11). There is no evidence of record in support of applicant's perception of its mark. In our view, it is not certain how consumers will perceive the word GREEN in the respective marks. Consumers may well perceive the word in both marks in its ordinary sense as the name of a color. On the other hand, to the extent, as applicant argues, that the term may suggest the outdoors or a clean environment, that same suggestion may be conveyed by the term "GREEN" standing alone.[6]

In view of the similarities pointed out above, applicant's and registrant's marks engender sufficiently

[6] We take judicial notice of the following dictionary definitions of the term "green." The term is defined as "of the color green; having the color of growing fresh grass; having abundant verdure; covered by green growth or foliage." Webster's Third New International Dictionary (unabridged ed. 1993). We also note this additional meaning: "(usu. Green): concerned with or supporting protection of the environment as a political principle." The New Oxford American Dictionary (2001).

similar overall commercial impressions as applied to the goods.

In sum, the marks, when considered in their entireties, create similar commercial impressions, and the differences between the marks are insufficient to distinguish them when used in connection with related goods. See In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)[“Viewed in their entireties with non-dominant features appropriately discounted, the marks [GASPAR’S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical.”]; In re The U.S. Shoe Corp., 229 USPQ 707 (TTAB 1985)[CAREER IMAGE (stylized) for clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms]; and In re Apparel Ventures, Inc., 229 USPQ 225 (TTAB 1986)[SPARKS BY SASSAFRAS (stylized) for clothing held likely to be confused with SPARKS (stylized) for footwear].

The disclaimer of the word GREEN apart from applicant’s mark does not impact our analysis inasmuch as disclaimed terms must be considered when comparing the marks. In re National Data Corp., supra at 751 [“the technicality of a disclaimer in [an] application to register [a] mark has no legal effect on the issue of likelihood of confusion”]; and In re MCI Communications

Corp., 21 USPQ 2d 1534, 1537 (Commr. 1991) [“disclaimer of matter will never serve to obviate the issue of likelihood of confusion”].

Applicant introduced more than seventy third-party registrations of marks comprising, in part, the term GREEN covering clothing and footwear. Applicant argues that this evidence shows that “the term ‘green’ is exceedingly weak as applied to items of wearing apparel including footwear.” (Brief, pp. 3-4). A few of the marks (as for example, GREEN BRAND, GREEN LABEL, GREEN GEAR and THE GREEN COLLECTION) are closer to the marks involved herein than are others (as for example, GREEN EAGLE, GREEN RIVER, THE GREENE TURTLE and GREEN IGUANA where the additional wording alters the meaning of the marks). We also note that other than registrant’s cited mark GREEN, there are no registrations of GREEN per se. In any event, the third-party registrations of these marks do not compel a different result. As often stated, this evidence does not establish that the registered marks are in use or that the public is familiar with them. AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); and Lilly Pulitzer, Inc. v. Lilli Ann Corp., 376 F.2d 324, 153 USPQ 406 (CCPA 1967). Accordingly, this type of evidence is of extremely limited value in likelihood of

confusion determinations. United Foods Inc. v. J.R. Simplot Co., 4 USPQ2d 1172, 1174 (TTAB 1987).

Applicant also argues that the presence of BY MISSAKO in its mark serves to reduce the likelihood of confusion between the marks. Although we certainly have considered BY MISSAKO in comparing the marks in their entireties, this portion of the mark, as noted earlier, is very small in size relative to the rest of applicant's mark. Further, it is more likely that consumers will refer to the goods as GREEN, as opposed to the entire phrase GREEN BY MISSAKO. Thus, in contrast to applicant's contention on this point, we do not view the addition of BY MISSAKO to be sufficient to render the marks as a whole distinguishable. See In re Christian Dior, S.A., 225 USPQ 533 (TTAB 1985).

We conclude that consumers familiar with registrant's footwear, shoes, boots, sandals, huaraches and slippers sold under the mark GREEN would be likely to believe, upon encountering applicant's mark GREEN BY MISSAKO and design for clothing and related clothing accessories, that the goods originate with or are somehow associated with or sponsored by the same source.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior

registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register as to the goods identified in Class 25 is affirmed. The application will proceed to publication for the services recited in Class 35.